

Remarks

Reconsideration and allowance of this application are respectfully requested.

The Examiner rejected original claims 1-14 under 35 U.S.C. 102(b) "as being clearly anticipated by Tate et al. (3,733,477)."

The Examiner also rejected original claims 1-14 under 35 U.S.C. 102(b) "as being clearly anticipated by Yoshida (5,638,314)."

Additionally, the Examiner rejected claims 12-14 under 35 U.S.C. 101 "because the claimed invention is directed to non-statutory subject matter."

The Examiner's rejections under 35 U.S.C. 102(b) based on Tate et al. and Yoshida are respectfully traversed.

The Examiner's 35 U.S.C. 101 rejection of claims 12-14 have been overcome by the amendment to claim [13] 12 made herein.

The presently active claims are original claims 1-11 and 13-14 and amended claim 12.

The Examiner's 35 U.S.C. 102(b) rejections will next be considered.

It is well established that "A claim is anticipated under 35 U.S.C. 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. V. Union Oil Co. of California, 814 F2nd 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (see also MPEP 2131).

Additionally, as held in the recent CAFC decision, Trintec Industries, Inc. v. Top-U.S.A. Corp (CAFC 7/2/02), "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." In re Robertson, 169, F.3d 743 45 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Still further, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijakaert, 9F.3d, 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. Ap. & Inter. 1990) (emphasis in original). (Also see MPEP 2112).

Additionally note the recent CAFC decision Elan Pharmaceuticals v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373 (CAFC, Oct. 2, 2003) which holds that: "The disclosure in an anticipating reference must be adequate to enable the desired subject matter. It is insufficient to name or describe the desired subject matter, if it cannot be produced without undue experimentation."

The Examiner's 35 U.S.C. 102(b) rejections based on Tate (page 2, item 4) and Yoshida (page 3, item 5) are not well taken.

The Tate and Yoshida patents are unquestionably directed to a divisor approach whereby the quotient and final remainder value are generated in a manner basically similar to manual long division using successive iterations and partial remainders. Although a final partial remainder is ultimately obtained in the Tate et al. and Yoshida embodiments, it clearly has not been obtained in the manner required by applicant's claims.

Note that independent claim 1 requires that each subtraction circuit subtract the respective test value (representing a respective integer multiple of divisor) from the common dividend signal to produce a respective remainder signal and a respective borrow carry/borrow signal. Logic coupled to receive these corresponding carry/borrow signals then determines which of the remainder signals represents a true remainder of the division by the divisor.

The embodiments disclosed by Tate et al. and Yoshida do not meet the above recitations of claim 1, since the resulting remainder from the first subtraction is a partial remainder which does not represent a true remainder of the division of the dividend by the divisor. Such a true remainder is obtained in the Tate et al. and Yoshida embodiments only after the required number of iterations have been performed.

In view of the foregoing, independent claim 1 along with claims 2-11 dependent thereon are not subject to the Examiner's 35 U.S.C. 102(b) rejection based on Tate et al. and Yoshida. Independent claim 12 (which includes the same basic limitations as claim 1) along with claims 13 and 14 dependent thereon are likewise not subject to this 35 U.S.C 102(b) rejection.

Note that the dependent claims also recite limitations not anticipated by Tate et al. or Yoshida. For example, claim 4 requires that the respective test values be hard coded in the circuit. The Examiner has not shown where such is found in either Tate et al. or Yoshida. Also, the Examiner has not shown where Tate et al. or Yoshida meets the recitation in claims 8 and 13 requiring the dividend to have a specific range from 0 to 65535 inclusive and for the divisor to have a fixed value of 9973. It is respectfully submitted that these recitations in claims 8 and 13 are not properly considered to be an intended field of use. Furthermore, even if Tate et al. and Yoshida are capable of operating on these values this would not in any case be adequate for a proper 35 U.S.C. 102(b) rejection (see previous discussion of 35 U.S.C. 102(b)).

Allowance of this application is accordingly respectfully solicited.

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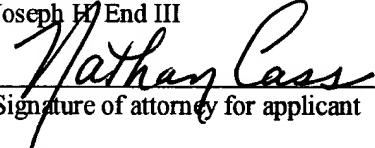
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